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EXAMINER DONADO, FRANK E				
ART UNIT 2617		PAPER NUMBER		
NOTIFICATION DATE 03/19/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/553,351

Applicant(s)

SAKAMOTO, KENJI

Examiner

FRANK DONADO

Art Unit

2617

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4-9, 11, 14-16, 19 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-9, 11, 14-16, 19 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/808)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The amendment filed on 12/08/08 has been entered. Claims 1, 4-9, 11, 14-16, 19 and 21 have been amended. Claims 2-3, 10, 12-13, 17-18, 20 and 22 have been cancelled. No claims have been added. Claims *1, 4-9, 11, 14-16, 19 and 21* are currently pending in this application, with claims 1 and 11 being independent.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 1, 6-9, 11, 16, 19 and 21 and 16-22 rejected under 35 U.S.C. 102(b) as being anticipated by Shintai, et al (**US PG Publication 2003/0022674**). From now on, Shintai, et al, will be referred to as Shintai.

Regarding claim 1, Shintai teaches a wireless terminal (**Cellular Phone unit 1 of Figure 1**) when connected to a base device (**Said cellular phone designates a base station with which to connect, Paragraph 10, lines 1-9**), receiving video data or audio data or both video and audio data from the connected base device (**Audio data is received at Said cellular phone, Paragraph 22, lines 1-9**), comprising: connection requesting means for broadcasting a connection request command that requests a connection with a base device (**Said designation occurs upon a user request,**

Paragraph 49, lines 1-10); connection establishing means for obtaining only a first incoming one of sets of identification data **(Said cellular phone receives base station identification numbers, where a primary connection will occur between said cellular phone and only one base station included in and corresponding to one of said base station identification numbers, Paragraph 10, lines 1-9),** each set being transmitted from a base device in response to the connection request command and specifying the respective base device **(Said identification numbers received from base stations, where said identification numbers specify corresponding base station of said cellular phone, Paragraph 10, lines 1-9),** so as to establish a connection with a base device that is indicated by the thus obtained, first incoming set of identification data **(Said designation of base station indicates connection with said base station, Paragraph 10, lines 4-9),** the base station having the established connection being the connected base station **(Said designation of base station indicates connection with said base station, Paragraph 10, lines 4-9);** connection completion notifying means for, after the obtaining of the first incoming set of identification data, broadcasting a connection process completion command that indicates that the connection with the connected base device is established **(Said cellular phone sends said base station identification data to a location information server, Paragraph 10, lines 9-11);** and connection counterpart notifying means for notifying, based on the first set of identification data, a user of the base device to which the wireless terminal is currently connected **(A data communication mode is set up with a designated base station, based on said base station**

identification numbers corresponding to said designated base station included in said set of base station identification numbers, Paragraph 10, lines 1-9 and Paragraph 23).

Regarding claims 6, Shintai teaches a wireless terminal and a wireless system as set forth in claim 1, comprising: image output means for causing display means to display an image based on video data received from the base device to which the wireless terminal is connected, the connection counterpart notifying means displaying the identification data on the display section in an OSD manner **(A contents server transmits game/video applications data to said cellular phone, Paragraph 25, lines 4-8).**

Regarding claim 7, Shintai teaches a base device comprising: identification data transmission means for transmitting the identification data to the wireless terminal as set forth in claim 1 **(Paragraph 23, lines 1-5).**

Regarding claim 8, Shintai teaches a wireless system comprising: the wireless terminal as set forth in claim 1 **(See Claim 1);** and a base device comprising identification data transmission means for transmitting the identification data to the wireless terminal as set forth in claim 1 **(Paragraph 23, lines 1-5).**

Regarding claims 9, Shintai teaches a computer readable storage medium storing a control program for operating a wireless terminal as set forth in claim 1, the control program causing a computer to function as each of the means (**Paragraph 57**).

Regarding claim 11, Shintai teaches a wireless system comprising a base device and a wireless terminal (**A cellular phone communicates with a base station, Paragraph 10, lines 1-9**) which, when connected to a base device (**Said cellular phone designates a base station with which to connect, Paragraph 10, lines 1-9**), receives either video data or audio data or both video and audio data from the connected base device (**Audio data is received at Said cellular phone, Paragraph 22, lines 1-9**), wherein: the wireless terminal comprises: connection requesting means for broadcasting a connection request command that requests a connection with a base device (**Said designation occurs upon a user request, Paragraph 49, lines 1-10**); connection establishing means for obtaining only a first incoming one of sets of identification data (**Said cellular phone receives base station identification numbers, where a primary connection will occur between said cellular phone and only one base station corresponding to one of said base station identification numbers, Paragraph 10, lines 1-9**), each set being transmitted from a base device in response to the connection request command and specifying the respective base device, so as to establish a connection with a base device that is indicated by the thus obtained, first incoming set of identification data (**Said identification numbers received from base stations, where said identification**

numbers specify corresponding base station of said cellular phone, Paragraph 10, lines 1-9), the base station having the established connection being the connected base station **(Said designation of base station indicates connection with said base station, Paragraph 10, lines 4-9);** connection completion notifying means for, after the obtaining of the first incoming set of identification data, broadcasting a connection process completion command that indicates that the connection with the connected base device is established **(Said cellular phone sends said base station identification data to a location information server, Paragraph 10, lines 9-11);** first connection confirming mode transiting means for causing transition into a connection confirmation mode in accordance with input of an instruction from a user **(The dormant mode and the standby mode are employed for receiving the base station id's before a locationing server confirms the base station id's have been received by commencing a positioning function, Paragraph 23, lines 1-7, Paragraph 24, lines 1-7, Paragraph 26, lines 1-6 and Figure 3);** connection confirming means for obtaining, after the transition to the connection confirmation mode, a connection confirmation command from the base device to which the wireless terminal is connected, the connection confirmation command being for confirming the connection **(A locationing server confirms the base station id's have been received by commencing a positioning function, Paragraph 24, lines 1-7);** and warning means for warning the user if the connection confirmation means does not obtain the connection confirmation command within a predetermined time after the transition to the connection confirmation mode **(A timer is used to check whether or not a**

communication with the base station has been established within a prescribed time after the positioning command has been received, Column 31, lines 1-9), and the base device comprises: identification data transmission means for transmitting the identification data after receiving a connection request command (**Said designation of base station indicates connection with said base station, Paragraph 10, lines 4-9);** means for, after receiving the connection process completion command, recognizing that the connection is established and transmitting either video data or audio data or both video and audio data to the wireless terminal (**Audio data is received at Said cellular phone, Paragraph 22, lines 1-9);** second connection confirming mode transiting means for causing transition into the connection confirmation mode in accordance with the input of the instruction from the user; and connection confirmation command transmitting means for transmitting the connection confirmation command, if the transition into the connection confirmation is performed (**The same process described above may be performed using either a dormant or standby mode during which base station id's are received, Column 26, lines 1-6).**

Regarding claim 16, Shintai teaches a wireless system as set forth in claim 11, comprising: image output means for causing display means to display an image based on video data received from the base device to which the wireless terminal is connected (**A contents server transmits game/video applications data to said cellular phone, Paragraph 25, lines 4-8),** the warning means warning the user by displaying a warning message on the display section in an OSD manner (**Said timer**

used to check whether or not a communication with the base station has been established within a prescribed time after the positioning command has been received triggers a deactivation of said cellular phone to dormant mode, Paragraph 33, Paragraph 34, lines 1-6 and Paragraph 35, lines 1-4 and Steps S4, S7, S8 and S9 of Figure 3).

Regarding claim 19, Shintai teaches a computer readable storage medium storing a control program for operating a wireless terminal constituting the wireless system as set forth in claim 11, the control program causing a computer to function as each of the means (**Paragraph 57**).

Regarding claim 21, Shintai teaches a computer readable storage medium storing a control program for operating a base device constituting the wireless system as set forth in claim 11, the control program causing a computer to function as each of the means (**Paragraph 57**).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 4, 5, 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shintai, in view of Pihl, et al (**US PG Publication 2003/0186707**). From now on, Pihl, et al, will be referred to as Pihl.

Regarding claims 4 and 14, Shintai teaches a wireless terminal as set forth in claims 1 and 11, respectively. Shintai fails to teach the identification data contains a key for encrypting the data and a key for decrypting the encrypted data. Pihl teaches the identification data contains a key for encrypting the data and a key for decrypting the encrypted data (**Paragraphs 38-39, Paragraph 44 and chart that follows**). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Shintai to include an encryption/decryption unit for the benefit of added security.

Regarding claims 5 and 15, Shintai teaches a wireless terminal as set forth in claims 4 and 14, respectively. Shintai fails to teach the key for encrypting the data and the key for decrypting the encrypted data are algorithms specific to the base device

indicated by the identification data. Pihl teaches the key for encrypting the data and the key for decrypting the encrypted data are algorithms specific to the base device indicated by the identification data **(An algorithm may be used to determine whether base station location charges are applicable, Paragraphs 38-39, Paragraph 44 and chart that follows)**. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Shintai to include an encryption/decryption unit for the benefit of added security.

Response to Arguments

7. Applicant's arguments regarding claims 1 and 11, filed 12/08/08, have been fully considered but they are not persuasive for the following reasons:

Regarding the non-targeted base devices appearing to the user to be operating normally even though the non-targeted base devices are not the intended target of the user, a signal quality measurement taken during locationing positioning of said cellular phone prevents this from happening in a way that is understood by those in the art (Paragraph 23, lines 1-6).

Regarding Shintai not teaching a "connection counterpart notifying means for notifying, based on the first set of identification data, a user of the base device to which the wireless terminal is currently connected", enabling the user to know whether the video data being received by the wireless terminal is coming from the desired base

device, a data communication mode is set up with a designated base station, based on said base station identification numbers corresponding to said designated base station included in said set of base station identification numbers (Paragraph 10, lines 1-9 and Paragraph 23), and a contents server transmits game/video applications data to said cellular phone (Paragraph 25), where said cellular phone transitions from said dormant mode to a data communications mode in conjunction with said signal quality measurement mentioned in the previous argument, (Paragraph 10, lines 1-9, Paragraph 23 and steps S9-S11 in Figure 3).

Regarding the wireless terminal of Shintai not teaching alerting the user ("warning" of claim 11) so that the user knows whether the video data being received by the wireless terminal is coming from the desired base device, a timer, used to check whether or not a communication with the base station has been established within a prescribed time after the positioning command has been received, triggers a deactivation of said cellular phone to dormant mode, indicating the user will know whether said video data being received by the wireless terminal (see above argument) is coming from the desired base device Paragraph 33, Paragraph 34, lines 1-6 and Paragraph 35, lines 1-4 and Steps S4, S7, S8 and S9 of Figure 3.

Regarding Shintai not disclosing the cellular phone broadcasting a connection request command, said designation (see above argument) occurs upon a user request (Paragraph 49, lines 1-10)

Regarding Shintai not disclosing the cellular phone broadcasting a connection completion command, said data communication mode (see above argument) serves as the connection completion command, where said data communication mode indicates a transition from a dormant mode where the connection has not been completed as of yet to a mode where the connection has been completed (Paragraph 10, lines 1-9, Paragraph 23 and steps S9-S11 in Figure 3).

Regarding Shintai not incurring the same problem of the present invention of, a base station without a connection to the terminal (e.g., cellular phone) that transmits video data by an erroneous recognition of a successful establishment of a connection and other base stations not transmitting video to the cellular phone, in other words, the non-optimal base station transmitting video data to said cellular phone, said timer mechanism that triggers said warning in conjunction with signal quality measurement (see above argument) prevents this from occurring, because the quality measurement allows for the optimum base station to be selected, and the timer allows the data communication that is occurring to correspond to the base station that is currently the optimal base station for communication.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to FRANK DONADO whose telephone number is (571) 270-5361. The examiner can normally be reached Monday-Friday, 9:30 am-6 pm, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rafael Perez-Gutierrez can be reached on 571-272-7915. The fax phone number for the organization where this application or proceeding is assigned is 571-270-6361.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-273-8300.

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/Rafael Pérez-Gutiérrez/

Supervisory Patent Examiner, Art Unit 2617